

REMARKS

Summary of the Office Action

Claims 1, 3-5, 9, 45-49, and 53 are pending in the above-identified patent application.

The Examiner rejects claims 1, 3-5, 9, 45-49, and 53 under 35 U.S.C. § 103(a) as being obvious from Bessler et al. United States Patent No. 5,855,601 (hereinafter "Bessler").

Summary of Applicants' Reply

Applicants have cancelled claims 2, 6, 8, 11-19, 21, 22, 26, 28, 31-44, 50, and 52 without prejudice. The cancellation of these claims complies with the Examiner's requirement in the Final Office Action to cancel all non-elected claims.

The Examiner's rejection is respectfully traversed.

Reconsideration of this application is respectfully requested in light of the following remarks.

Applicants' Reply to the Bessler Rejection

Claims 1, 3-5, 9, 45-49, and 53 are rejected under 35 U.S.C. § 103(a) as being obvious from Bessler. This rejection is respectfully traversed.

Applicants assume that the statement on page 2 of the Final Office Action that "claims 1, 3-5, 9, 45-49, 53 are

rejected under 35 U.S.C. 102(e) as anticipated by ...

Bessler" is erroneous because the Examiner later states in the Response to Arguments section of the Final Office Action that "the 35 U.S.C. 102 portion of the rejection has been withdrawn."

Applicants' claimed invention relates to heart valves comprising a valve portion, a connector band, and a plurality of barbed fingers oriented substantially parallel to the direction of blood flow and adapted to secure the valve to a tissue annulus.

Bessler shows an artificial heart valve comprising a flexible valve, a stent member surrounding the valve, and a plurality of "barbs" arranged on the outside surface of the stent member.

Applicants respectfully submit that the rejection of claims 1, 3-5, 9, 45-49, 53 under 35 U.S.C. § 103(a) as being obvious from Bessler is traversed. The Examiner does not provide evidence to show that the use of barbed fingers is common knowledge in the art. According to MPEP § 2144.04, Section E, "it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based." Although, the Examiner attempts to support this

rejection by citing Lazarus United States Patent No. 6,416,535 (hereinafter "Lazarus"), Lazarus is not prior art to this application because Lazarus fails to predate the April 23, 1999 filing date of United States Provisional Application No. 60/130,758, from which this application claims priority.

Furthermore, a prima facie case of obviousness cannot be established because there is no suggestion or motivation, either in Bessler or in the knowledge generally available to one of ordinary skill in the art to modify Bessler by replacing the "barbs" in Bessler with barbs in the well-known sense, as described in detail in the previous Reply to Office Action.

In fact, Bessler teaches away from using barbs in the well-known sense. One skilled in the art would not find motivation in Bessler to disregard the teachings of Bessler and replace the pointed extrusion that Bessler has labeled a "barb" with a barb in the well-known sense. Bessler must be considered as a whole, including portions that teach away from using a barb in the well-known sense. See MPEP § 2141.02. The only possible motivation for replacing the "barbs" in Bessler with barbs in the well-known sense is

hindsight reconstruction using applicant's disclosure as a blueprint.

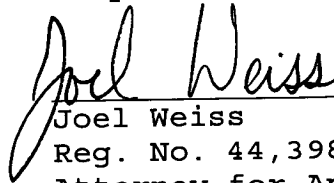
"[H]indsight-based obvious analysis" has been characterized by the Federal Circuit as a "subtle but powerful attraction." In re Dembizcak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), limited on other grounds by In re Gartside, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000). One simply "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361, 1371, 56 USPQ2d 1065, 1072, rehearing denied, suggestion for rehearing en banc declined (Fed. Cir. 2000), citing In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1998).

For at least the reasons stated above, applicants' invention is not obvious from Bessler. Therefore, independent claims 1 and 45 and dependent claims 3-5, 46-49, and 53 are in condition for allowance.

Conclusion

For at least the reasons stated above, claims 1, 3-5, 9, 45-49, and 53 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance are respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, reading "Joel Weiss", is written over a horizontal line.

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